

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claim 13 is pending and stands rejected.

In item 4(a) on page 1 and item 2 on page 2 of the Office Action, it was indicated that claims 1-12 and 14-16 are pending, but withdrawn. Please note that claims 1-12 and 14-16 were cancelled in the Amendment filed September 30, 2008. Thus, only claim 13 remains pending in this case.

Claim 13 is amended to include the negative limitation "with the proviso that R₁ cannot be a hydrogen atom, when R₄ is an alkyl group having 1 to 5 carbon atoms, and R₄ cannot be a hydrogen atom, when R₁ is an alkyl group having 1 to 5 carbon atoms". See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977); *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984); M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2173.05(i), 2100-228. Support can be found in original claim 13 and in the disclosure, for example, at page 11, line 255 to page 12, line 277. Other minor and non-narrowing revisions were made to the claim to better conform to US practice.

No new matter has been added.

II. INFORMATION DISCLOSURE STATEMENT

Attached to the Official Action was an Examiner-initialed PTO-1449 form for the Information Disclosure Statement (IDS) filed June 29, 2005. However, the Examiner did not check-off/initial the last three non-patent references listed thereon, which are the following: (i) G. Schroeter, Lieb, Ann, Der Chemie, Vol. 418, pp. 161-257, (1919); (ii) Biol. Aktiv. Soedin., pp. 64-69 (1968); and (iii) Armyanskii Khimicheskii Zhurnal, 21, pp. 393-396 (1968). No explanation was given as to why these references were not officially considered by the Examiner.

An English translation of each of these non-patent references (i), (ii) and (iii) is provided in the Appendix.

Therefore, the Office is requested to kindly consider these references cited in the IDS of June 29, 2005 and return an Examiner-initialed PTO-1449 form indicating such.

III. FOREIGN PRIORITY

Acknowledgment has been made of the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). However, the Examiner has indicated that the certified copies of the foreign priority documents (Japanese Patent Application

Nos. 2003-416516 and 2004-317301) have not been received at the USPTO. See item 3 on page 2 of the Office Action.

Applicants respectfully disagree and submit that certified copies of the foreign priority documents should be of record at the USPTO as they should have been submitted by the International Bureau to the USPTO as per US practice. See M.P.E.P. § 1893.03(c), II. Please review the USPTO files for the certified copies and acknowledge receipt of such.

Furthermore, according to PCT Rule 17.2, the International Bureau furnishes a copy of the priority document to the USPTO upon request, and the USPTO cannot ask the applicant to furnish it with a copy.

IV. PRIOR ART REJECTION

Claim 13 was rejected under 35 U.S.C. § 102(b) as being anticipated by Armand (US 4,818,644) for the reasons in item 5 on pages 2-3 of the Office Action. This rejection is respectfully traversed.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, claim 13 is amended to include the negative limitation "with the proviso that R₁ cannot be a hydrogen atom, when R₄ is an alkyl group having 1 to 5 carbon atoms, and R₄ cannot be a hydrogen atom, when R₁ is an alkyl group having 1 to 5 carbon atoms". This amendment

excludes the compound (in col. 1, lines 7-51) in Armand relied upon by the Examiner in making this rejection.

Therefore, the present amendment renders the rejection moot. Withdrawal of the rejection is requested.

V. DOUBLE PATENTING REJECTION

Claim 13 was provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending US Application No. 10/582,855 for the reasons on page 4 of the Office Action.

Since the rejection is provisional, kindly hold the rejection in abeyance until allowance of the instant application or the copending application, in accordance with US practice.

VI. CONCLUSION

Having addressed all the outstanding issues, the amendment is believed to be fully responsive. The application is believed to be in condition for allowance and notice to that effect is requested. If the Examiner has any proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

/Robert A. Madsen/

Robert A. Madsen, Reg. No. 58,543
209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

RAM/lrs

APPENDIX:

The Appendix includes the following items:

- An English translation of G. Schroeter, Lieb, Ann, Der Chemie, Vol. 418, pp. 161-257, (1919);
- An English translation of Biol. Aktiv. Soedin., pp. 64-69 (1968); and
- An English translation of Armyanskii Khimicheskii Zhurnal, 21, pp. 393-396 (1968).